

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	10/081,034 034	Confirmation No.	1669
Applicant	Philippe R. MURCIA		
Filed	February 21, 2002		
TC/AU	1772		
Examiner	Donald J. LONEY		
Docket No.	103533-43091		
Customer No.	26345		

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PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Responsive to the Office Action dated September 5, 2003, applicant petitions for withdrawal of the Restriction Requirement.

Restriction was made between the following groups:

Group	Comprising Claims	Drawn to:
I	1-13	a process
II	14-24	an apparatus
III	25-31	a product

In the applicant's Response to restriction Requirement, it was shown that each group is in effect classified under Class 156. Although Group III is actually classified under Class 428, that is because of the following note for Class 156 found in the Classification manual:

This class does not provide for products of manufacture.
 Class 428, Stock Material or Miscellaneous Articles . . .".

Thus, by direction, products of Class 428 fall under Class 156. In view of this common classification, restriction is improper.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be

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practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another materially different process. MPEP § 806.05(e). The Office Action of paper no. 3 contended that the apparatus can be used to practice another and materially different process such as one which uses new material instead of recycled material and/or uses plastic veneer instead of wood veneer since the materials are not limiting within the apparatus claims.

Claims 14-24 are apparatus counterparts to method claims 1-13. Indeed, the claim language of independent apparatus claim 14 corresponds to that of independent claim 1 except that "means for" precedes each element. Further, since claims 1-13 are directed to a method, paper no. 3 fails to show how substituting new material for recycled material or substituting plastic veneer for wood veneer, which are not process limitations at all, constitute a materially different process from that of claims 10-13. Indeed, the apparatus claim 14 calls for, among other things, a means for transforming wood waste into sheets of wood veneer. The claimed apparatus elements, therefore, do not indicate that substituting new material for wood waste would render the transforming means operative for the substituted material, i.e., that substituting plastic for wood can be handled by the transforming means to form plastic veneer in place of wood veneer. Further, assuming such substitution is feasible to effect transforming, there is no indication that the rest of the claim elements that interact with the wood veneer in some manner would be operative if plastic veneer were substituted for wood veneer. Finally, there is no showing that the same substitutions can not be made for the claimed method so as to avoid being a materially different process.

Claims I and III are related as process or making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process.

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MPEP § 806.05(f). Paper no. 3 contends that the product can be made by a materially different process such as one which does not ascertain abrasion and/or mechanical resistance of the materials used or uses new materials instead of recycled ones.

It is true that the product of manufacture claims 25-31 could be made by eliminating the ascertaining step of claim 1. However, such an omission does not represent a materially different process used to form the product, but rather one that is broader in scope than claim 1 to form the product. As concerns using new materials for recycled ones, both claims 1 and 25 call for recycled or waste material so the hypothetical substitution by new material is not a viable alternative. For these reasons, restriction is improper.

Claims II and III are related as apparatus and product made. The inventions are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus. MPEP § 806.05(g). Paper no. 3 contends that the apparatus claimed can be used to make a materially different article such as one which uses new materials and/or plastic veneer instead of wood.

Claim 14 includes the recitation of "means for transforming wood waste into sheets of wood veneer". There is no showing that the transforming means, which is configured for transforming wood waste into sheets of wood veneer, is also capable of transforming new materials to form plastic veneer, particularly in light of the material characteristic differences between plastic and wood. Further, the Office Action fails to show how a substitution of new material for recycled material constitutes a materially different article over one that uses the recycled material instead.

The Examiner's rebuttal in paper no. 5 is that any type of materials may work, but such has not been shown to be the case in view of the claim language and such a

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contention further defies common sense. Wood and other types of materials, such as plastic, have material characteristics that differ from each other because of differences in their respective composition and densities. Consider claim 14. Equipment configured to transform wood waste into sheets of wood veneer may be incapable of transforming plastic into plastic veneer, because the equipment employed is configured to be used for wood transformation as opposed to plastic transformation. For instance, if plastic is harder than wood, then an apparatus that is just capable of cutting through the hardness of wood may not be capable of cutting through the hardness of plastic to transform the same.

Indeed, one type of apparatus that is envisioned to effect the transformation (e.g. claim 18), compounds sawdust from the wood waste. However, plastic or other materials can not take the form of sawdust. Only wood can be made into sawdust so that substituting plastic for wood waste would mean the equipment of claim 18 could not be used. Similarly, the step of transforming wood waste into sheets of wood veneer does not mean that such a step would transform plastic into plastic veneer, particularly since different techniques are employed for each (see claim 18, for instance).

Finally, the examiner relies in paper no. 5 on contending showing one way distinction as opposed to two way distinction. Based on the foregoing, it is submitted that the examiner has not shown one way distinction.

MPEP 803 Guidelines provide:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant...Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a).

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Here, the applicant has rebutted the *prima facie* the examiner's explanation of separate classification by showing that each group is in effect in the same class 156 (groups I and II) or via direction in the same class 156 (group III) to another class 428. The examiner contends that inventions have acquired a separate status in the art as shown by their different classification, but such a contention is unjustified, because the arbitrary classification system devised by the U.S. Patent and Trademark Office fails to reflect the status of invention in the art and further because the applicant has shown each of the inventions to be in effect classified in the same class.

Withdrawal of the restriction is warranted and requested.

Respectfully submitted,

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Application Number	10/081,054 10/081,034
Filing Date	February 21, 2002
First Named Inventor	Philippe R. MURCIA
Art Unit	1772
Examiner Name	Donald J. LONEY
Attorney Docket Number	103533-43091

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Remarks

1. Petition For Withdrawal of Restriction Requirement

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Robert J. Hess (Reg 32,139) - Gibbons, Del Deo, Dolan, Griffinger & Vecchione
Signature	<i>Robert Hess</i>
Date	December 5, 2003

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December 5, 2003

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